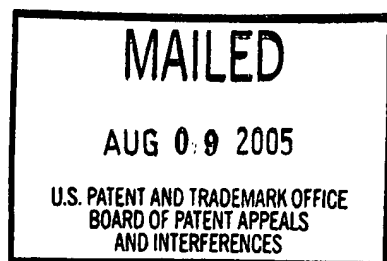


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DERRICK J. DIMONE



Appeal No. 2005-0701
Application No. 10/036,178

ON BRIEF

Before WILLIAM F. SMITH, GARRIS, and JEFFREY T. SMITH,
Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

REMAND TO THE EXAMINER

For the reasons detailed below, the above identified application is not in condition for resolution of the subject appeal. In order to rectify this circumstance, the application is hereby remanded to the Examiner, via the Office of the Director for Technology Center 1700, for action consistent with our following comments.

The claims on appeal are directed to a filler for decorating an insignia. With reference to Figure 4 of the Appellant's drawing, the filler is for decorating an insignia 6 (e.g., the H

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surrounded by a box as an insignia for HONDA®) disposed on a surface (e.g., an automobile surface) and having at least one space 7 formed therein and exposing the surface comprising an insert 1 adapted to fill the space 7 and lie directly on the surface. This appealed subject matter is defined by claim 1, the Appellant's sole independent claim, in the following manner:

1. A filler for decorating an insignia disposed on a surface and having at least one space formed therein and exposing the surface, comprising an insert adapted to fill the space and lie directly on the surface.

As set forth in the final Office action mailed June 4, 2003 which was referenced on page 3 of the answer, claims 1-5 and 7-14 (i.e. all of the claims on appeal) stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fielder (a.k.a. Fielder et al) in view of Noone. The Examiner expresses her position concerning this rejection on pages 2 and 3 of the final Office action as follows:

Fielder et al., disclose a decorative article that is used as a covering for an automotive component, (column 4, lines 14-16). The substrate of the article is a vinyl sheet with a lens cap placed over the substrate, (column 3, lines 10-20). The vinyl may be a solid color, pattern, or have indicia printed on it, (column 4, lines 23-35). The decorative article is adhered to a surface by a coating of adhesive applied to the bottom side of the vinyl sheet. Fielder et al

also disclose that it is known in the art to use trim strips of various configurations and decorative articles and emblems to decorate an automotive body, (column 1, lines 19-26).

Noone discloses a sports theme kit for outfitting an automobile that includes a signs [sic] that can be temporarily affixed to the vehicle through the use of magnets. The signs are made of a flexible magnetic sheet. On vehicles parts that magnets would not adhere [sic], the backing should have an adhesive material, (column 5, lines 28-33).

Noone also discloses that a roll of flexible tape is decorated with the team's colors that can be trimmed to the desired length, (column 5, lines 4-16). Hubcap decals can also be trimmed to size by the consumer, (column 5, lines 17-26).

Although, Fielder et al do not specifically disclose that the adhesive should be double-sided tape, it is within the skill of one in the art at the time of [the] invention to substitute double-sided tape for the adhesive so as to more easily remove the decorative article from the automobile without causing damage to the automobile surface.

Because the inventions of Fielder et al and Noone are drawn to articles used to decorate automobiles, wherein the decorative materials are composed of layered materials on a substrate, it would have of been obvious to one skilled in that art at the time of [the] invention to modify the decorative material of Fielder et al with the attachment means of Noone to obtain a decorative material that adheres directly to the surface of the automobile without permanently damaging the vehicle exterior. In addition, it would also be within the skill of one in the art to trim the decorative article of Fielder et al to fit the area where the decoration is desired as evidenced by the Noone reference that further discloses that decorative articles can be trimmed to the desired size to obtain a customized automobile decoration.

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Even a superficial study of this rejection immediately reveals that the Examiner has failed to follow the appropriate guidelines to be applied in formulating an obviousness rejection. For example, see the guidelines set forth in the Manual of Patent Examining Procedure (MPEP) at § 2141 et. seq. (Rev. 2, May 2004). In particular, the Examiner's above quoted explanation of her rejection does not address independent claim 1 specifically (which is the only claim argued on this appeal) and thus does not proffer her broadest reasonable interpretation of this claim consistent with the subject specification or the differences between this claim as so interpreted and her primary reference to Fielder. Concomitantly, the rejection does not contain any reasonably specific discussion of these differences and her reasons for believing that one having ordinary skill in this art would have found it obvious to combine Fielder and Noone in such a manner as to eliminate such differences.

Because of the Examiner's above discussed failures, it is not possible to meaningfully assess the merits of the rejection before us. Indeed, the propriety of this rejection could not be assessed even if we were to assume that each one of the Examiner's several proposed modifications of Fielder would have been obvious. Again, this is due to the fact that the Examiner has not provided the

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record of this appeal with her interpretation of the Appellant's independent claim. Therefore, we do not know what the Examiner's claim 1 interpretation is or whether it is proper or whether the Examiner's proposed modification of Fielder would correspond to this claim interpretation.

These deficiencies of the Examiner's rejection are not supplied by her responses to the Appellant's arguments which appear on pages 3-5 of the answer. In this regard, we observe that the Appellant's arguments are accurately paraphrased by the Examiner on page 3 of the answer as follows:

Applicant contends that neither Fielder et al nor Noone teach or suggest a decoration that is a filler material that is shaped to complement and decorate an automobile insignia. Applicant also contends that while the insignia and the material of the filler may be old, the combination of the two creates a new overall combined decoration that relies on qualities from the insignia and the filler that is not suggested in the prior art.

However, the Examiner's subsequent responses to these arguments do not expressly discuss why she is unpersuaded by the Appellant's argument that Fielder and Noone do not "teach or suggest a decoration that is a filler material that is shaped to complement and decorate an automobile insignia" (id.). In fact, the Examiner's responses to these arguments (and for that matter

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her rejection of the appealed claims) do not contain any reference at all to an automobile insignia much less an explanation of why she believes Fielder and Noone would have suggested "a decoration that is a filler material that is shaped to complement and decorate an automobile insignia" (id.).

To summarize, the fundamental underlying deficiency of the obviousness analysis advanced by the Examiner (and her conferees) on this appeal is the lack of an interpretation of the one and only claim argued by the Appellant in his brief. Concerning this deficiency, it is well settled that the analysis required under § 103 begins with the question "*what is the invention claimed?*", since "[c]laim interpretation ... will normally control the remainder of the decisional process." Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1566, 1568, 1 USPQ2d 1593, 1597 (Fed. Cir.), cert. denied, 481 U.S. 1052 (1987).

The pivotal role played by claim interpretation in the decisional process is especially critical when, as here, the claim under review appears to be subject to various interpretations. More particularly, appealed independent claim 1 is directed to "[a] filler" which is intended to be used "for decorating an insignia ... having at least one space formed therein." Thus, the claim unquestionably defines the subcombination of a "filler"

per se rather than the combination of a filler plus an insignia. Nevertheless, claim 1 defines this subcombination of a "filler" as "comprising an insert adapted to fill the space [in the insignia] and lie directly on the surface [on which the insignia is disposed]" (emphasis added). Thus, an interpretation of the "adapted to" language of claim 1 is paramount to effective claim construction.

It is beyond dispute that, during examination in the Patent and Trademark Office, claim language is to be given its broadest reasonable interpretation consistent with the specification.¹ In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). Thus, in order to properly interpret the "adapted to" language of claim 1, the Appellant's specification must be consulted. The following disclosure at lines 14-19 on specification page 10 appears relevant to this issue:

Fig. 4 shows an automobile insignia 6. The insignia 6 is a chrome insignia attached to the body of the automobile. The insignia 6 defines

¹Such an interpretation is necessary in order to achieve a complete exploration of an applicant's invention and its relationship to the prior art, so that ambiguities can be recognized, the scope and breadth of language explored, and clarification imposed. In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). The achievement of these critical desiderata has been forestalled in the subject appeal due to the previously discussed failures on the Examiner's part.

spaces 7 through which the underlying automobile is exposed. The colored inserts 1 are cut to match the spaces 7 and therefore complement the insignia 6. The colored inserts are then inserted into the spaces 7.

This disclosure plainly teaches that the Appellant's "inserts 1 are cut to match the spaces 7 and therefore complement the insignia 6" (id., at lines 17-18). In light of this teaching, it reasonably appears that the claim 1 insert is "adapted to fill the space [of an insignia] and lie directly on the surface [on which the insignia is disposed]" (claim 1) by way of being "cut to match the spaces 7 and therefore complement the insignia 6" (lines 17-18 of specification page 10).

It is not reasonably apparent, however, when such a cutting operation is to occur in the context of appealed claim 1. That is, the "adapted to" language of this claim might be interpreted as defining "a filler ... comprising an insert ..." which has been previously cut, for example, at a manufacturing facility, to match the insignia spaces and therefore complement the insignia. Under this interpretation, the ultimate user of the here claimed filler would be provided with a pre-cut insert. Alternatively, the "adapted to" language of claim 1 might be interpreted more broadly as merely requiring an insert which is capable of being cut,

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for example, by the ultimate user. Under this alternative interpretation, the ultimate user of the here claimed filler would be provided with a generic insert which must then be cut by the user in order to match the insignia spaces and therefore complement the insignia.

In response to this remand, the Examiner must provide the application file record with an interpretation of claim 1, particularly the "adapted to" language thereof, in accordance with our foregoing discussion. More specifically, the Examiner must assess whether the previously discussed claim interpretations are reasonable and consistent with the Appellant's specification. If both of these interpretations are determined to be reasonable and consistent with the specification, the Examiner must apply the broader interpretation to claim 1. Morris, 127 F.3d at 1054, 44 UPQ2d at 1027.

After so interpreting claim 1, the Examiner must reconsider whether the claim, as so interpreted, is rendered unpatentable by the prior art. For example, the Examiner may broadly interpret claim 1 as defining a filler comprising a generic insert which is merely capable of being cut, that is, a generic insert which is intended to be cut by the ultimate user in order to match insignia spaces and therefore complement the insignia. If so interpreted,

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the Examiner then should consider whether the decorative article of Fielder is capable of being cut because, if so, patentee's article would appear to anticipatorily satisfy all requirements of claim 1 as broadly interpreted.

In order to facilitate an effective response by the Examiner to this remand, we hereby vacate the outstanding § 103 rejection of all appealed claims as being unpatentable over Fielder in view of Noone. For the many reasons detailed above, this rejection utterly fails to comply with long established guidelines for assessing obviousness, thereby making such vacatur of this rejection particularly appropriate.

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This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is **not** made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) does not apply.

REMANDED

WILLIAM F. SMITH

Chief Administrative Patent Judge

BRADLEY R. GARRIS

BRADLEY R. GARRIS
Administrative Patent Judge

Frederic T. Smith
FREDERIC T. SMITH

JEFFREY T. SMITH
Administrative Patent Judge

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